IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant   :   Aravind Soundararajan , Chennai
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APPEAL BRIEF

Sir:

This is a brief for an appeal from a Final Office Action dated September 17, 2009, the Advisory action dated January 12, 2010, and from a Notice of Appeal mailed on January 19, 2010.

1. Real Party in Interest

The real party of interest is Trident Microsystems (Far East) LTD. of Grand Cayman, Cayman Islands, pursuant to the assignment recorded on February 13, 2010 at reel/frame 023928/0552.

2. Related Appeals and Interferences

There are no related appeals or interferences.

3. Status of Claims

Claims 1-31 were originally presented on the filing of the present application. Claims 1-4, 10-11, 14-15, and 18-21 were amended in a response filed May 27, 2008 to the Office Action of February 5, 2008. Claim 11 was amended in a response filed October 30, 2008 to the Office action of September 4, 2008. Claims 1, 3, 5, 9-12, 14, 17-18, 20, and 29 where amended in a response filed December 4, 2008 to the Office action of September 4, 2008. Claims 1-26 are currently pending. Claims 1-26 are presented on appeal. Claim 11 was amended in a response filed May 19, 2009 to the Office action of February 20, 2009.

4. Status of Amendments

A response after final that included no amendments to the claims was filed on December 15, 2009. No amendments to the claims have been filed subsequent to the Final Office Action of June 2, 2008.

5. Summary of the Claimed Subject Matter

Independent Claim 1

The invention claimed in independent claim 1 is method of communicating. The method of communicating comprising receiving a text message from a user of a set top box referred to as a source set top box (see p. 3 lines 15-19). The method also includes transmitting the text massage from the source set top box to an exchange (See Fig. 1 element 20 and p. 4 lines 1-3). At the exchange, the text message is packetized into a plurality of data packets. The data packets include the text message, an identifier for the source set top box, and packet header information (See Fig. 1 element 30 and p. 4 lines 3-18).
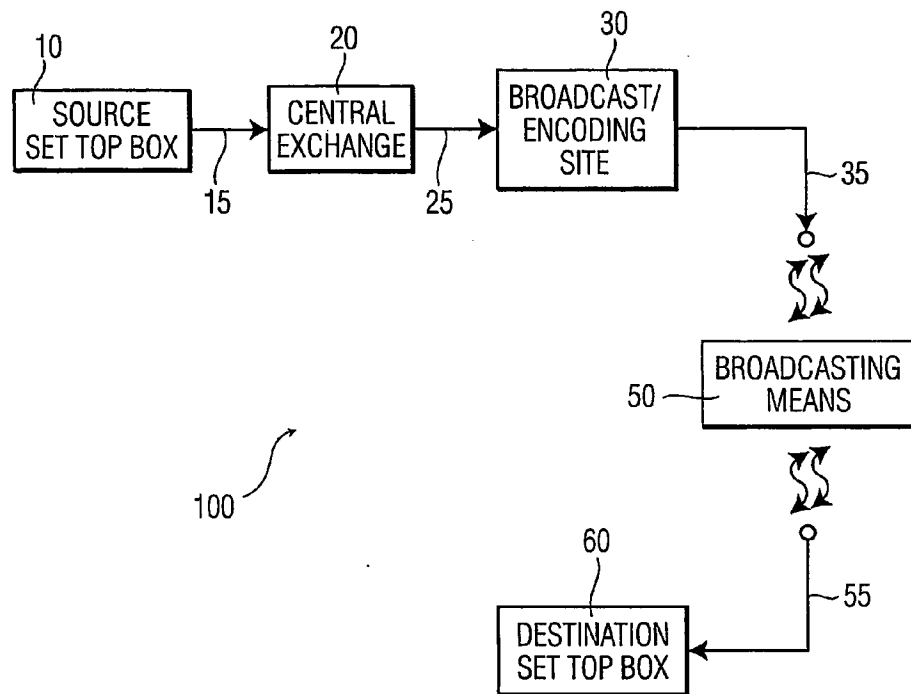

FIG. 1

The method further comprises forwarding the data packets to a multiplexor, and multiplexing the data packets with audio and video data into an output transport stream (See p. 4 lines 19-25). The output transport stream is broadcast to a plurality of set top box destinations, where one of the plurality of destination set top boxes is the destination set top box (See p. 5 lines 4-22).

Independent Claim 10

The invention claimed in independent claim 10 is method of communicating. The method comprises receiving a message from a first source set top box (See p. 3 lines 15-19) and packetizing the message into data packets. The data packets include the text message, an identifier of a first destination set top box, an identifier of the first source set top box, as well as packet header information (See Fig. 1 element 20 and p. 4 lines 1-3).

The method further comprises forwarding the data packets to a multiplexor that produces a transport stream containing the data packets, audio data and video data (See p. 4 lines 19-25). Finally, the method comprises broadcasting the transport stream to a plurality of destination set top boxes, where the plurality of destination set top boxes includes the first destination set top box (See p. 5 lines 4-22).

Independent Claim 14

The invention claimed in independent claim 10 is method of communicating. The method comprises receiving a plurality of text messages, where the text messages originated at a plurality of source set top boxes (See p. 3 lines 15-19). The method further comprises packetizing said plurality of text messages into a plurality of data packets, where the plurality of data packets includes the text messages, an identifier of an intended destination set top box for each of the text messages and an identifier of the source set top box for each of the text messages (See Fig. 1 element 20 and p. 4 lines 1-3).

The method also comprises multiplexing the data packets, audio data and video data into an output transport stream, as well as broadcasting said output transport stream to a plurality of destination set top boxes (See p. 4 lines 19-25). As defined by the method of claim 14 the set top boxes include each intended destination set top box for each of the text messages (See p. 5 lines 4-22).

Independent Claim 20

The invention claimed in independent claim 20 is a system for communicating. The system comprises a service station that receives a plurality of text messages sent from a source set top boxes (See p. 3 lines 15-19 and p. 5 lines 7-22). The service station packetizes said plurality of text messages into data packets (See Fig. 1 element 20 and p. 4 lines 1-3). The data packets include the text messages, an identifier of an intended

destination set top box for each of the text messages and an identifier of the source set top box for each of the text messages.

The system further comprises a multiplexor in communication with the service station. The multiplexor multiplexes the data packets with audio data and video data into an output transport stream (See p. 4 lines 19-25). The system also comprises broadcasting means for broadcasting the output transport stream to destination set top boxes. The destination set top boxes include the intended destination set top box for each of the text messages (See p. 5 lines 4-22).

Independent Claim 29

The invention claimed in independent claim 29 is a system for communicating. The system comprises a means for transmitting a text message from a source set top box along with a means for packetizing the text message into data packets (See p. 3 lines 15-19). The data packets include the text message, an identifier of said source set top box an identifier of a destination set top box for the text message, and packet header information (See Fig. 1 element 20 and p. 4 lines 1-3).

The system further comprises a means for multiplexing the data packets with audio data and video data into an output transport stream (See p. 4 lines 19-25). The system also comprises a means for broadcasting the output transport stream to destination set top boxes. The destination set top boxes include the destination set top box for the text message (See p. 5 lines 4-22).

6. Grounds of Rejection to Be Reviewed On Appeal

The issues on appeal are whether claims 1-31 are unpatentable under 35 U.S.C. §103 as being unpatentable over U.S. Patent Publication 2007/0124795 (McKissick) in view of U.S. Patent Publication 2003/0208777 (Danker) in further view of U.S. Patent 5,796,441 (Oshita).

7. Argument

Prior art: McKissick

McKissick discloses a television message system that allows users of television equipment devices that are connected to a television distribution facility to transmit messages to other users. The messages are sent from a television device to a television distribution facility where they are stored in a server. The messages may then be downloaded by users after they login to the message server (See McKissick Fig. 3 and Paragraphs 77 and 79).

Additionally, McKissick teaches providing "TV message information" distinct from the messages discussed above. The "TV message information "may be information "that indicates that the television program has associated message options such as those shown in Fig. 4". (See McKissick: paragraph 82).

Prior art: Danker

Danker discloses methods and systems of transmitting signals over a multiplexed channel (See Danker: Abstract). The signals are transmitted from hosting services to client devices (See Danker paragraphs 12-13 and 19-22). The hosting service stores information related to a client, and may transmit message data associated with a client identifier along with a content carrier signal (See Danker paragraph 3 and 11). The hosting service may also encrypt message information so it is only readable by certain clients (See Danker paragraph 13).

Prior art: Oshita

Oshita discloses a video coding apparatus (See Oshita: Abstract). The apparatus includes an encoder that encodes picture information into a compressed video data stream and a packet assembler that assembles this information into packets and adds header information to the packets (See Oshita: Col. 1 lines 62-67).

The Examiner fails to cite to any reference that teaches broadcasting text messages that are received from users of source set top boxes, as in the claimed invention

Applicant respectfully traverses the § 103(a) rejections of claims 1-31 because the Examiner fails to cite to any reference that teaches broadcasting text messages that are received from users of source set top boxes, as in the claimed invention.

The McKissick reference does not teach broadcasting messages received from users of set top boxes to the set top boxes of the desired recipients of these messages. Instead, the cited portions of the McKissick reference teach that messages can be exchanged between the users of television equipment devices 100 and 120; the messages are stored on message servers 106, 108 or 110 and the recipients user's set top box downloads the message from the message server after logging on to the message server. *See, e.g.,* Figure 3 and Paragraphs 0077 and 0079. In other words, the McKissick reference does not broadcast text messages to a plurality of destination set top boxes as in the claimed invention, but instead teaches that the set top boxes access messages stored on a server on an individual basis. The McKissick reference further teaches providing "TV message information" with the television program data, not the actual messages that are exchanged by the users. The TV message information is taught by the McKissick reference as being information "that indicates that the television program has associated message options such as those shown in FIG. 4." *See* paragraph 0082. Thus, the McKissick reference does not teach broadcasting the actual text messages. Instead, McKissick teaches communicating messages directly to and from users by way of an intermediate server, where the message information is sent directly to the recipient, either by downloading alone or with additional content, instead of being broadcast to a plurality of destinations.

In the Advisory Action of January 12, 2010, the Examiner points to paragraphs 95 and 145 of McKissick as teaching that a user may send a message to a group of viewers. These paragraphs, however, are only disclosing a message being sent directly to each member of a group as a separate message in response to each recipient accessing the server (e.g. by opening the user's inbox in McKissick paragraph 145). There is no teaching or disclosure that the user message is broadcast to a plurality of destination devices as part of an output transport stream.

The Danker reference, however, also does not teach broadcasting text messages that are received from users of source set top boxes. In fact, the Danker reference does not receive text messages from users of set top boxes. Instead, the Danker reference teaches providing message data sent by hosting services to client devices. *See, e.g.,* paragraphs 0012-0013 and 0019-0022. Applicant notes that the '441 reference is not alleged by the Examiner to teach broadcasting text messages received from users of source set top boxes as claimed. Because none of the cited reference teaches such aspects, no reasonable combination of these references can provide correspondence to the claimed invention. Accordingly, Applicants respectfully submit that the § 103(a) rejections of claims 1-31 are improper and Applicant requests that they be withdrawn.

The modification of the McKissick reference proposed by the Examiner would change the principle of operation of the McKissick reference

Applicant respectfully traverses the § 103(a) rejections of claims 1-31 (each of which is based on the McKissick reference) because the modification of the McKissick reference proposed by the Examiner would change the principle of operation of the McKissick reference. *See, e.g.,* M.P.E.P. § 2143.01 ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti,* 270 F.2d 810, 123 USPQ 349 (CCPA 1959).").

As discussed above, McKissick does not teach broadcasting messages received from users of set top boxes to the set top boxes of the desired recipients of these messages as part of a broadcast output stream. Instead, the cited portions of the McKissick reference teach that messages can be exchanged between the users of television equipment devices 100 and 120; the messages are stored on message servers 106, 108 or 110 and the recipients user's set top box downloads the message from the message server after logging on to the message server. *See, e.g.,* Figure 3 and Paragraphs 0077 and 0079. As also discussed above, McKissick teaches providing TV message information with the television program data, not the actual messages that are exchanged by the users (See McKissick paragraph 0082). Thus, the McKissick reference does not teach broadcasting the actual text messages with the television programming.

The Examiner proposes to modify the McKissick reference such that the messages exchanged between users of set top boxes would be multiplexed with audio and video signals and broadcast over a network as part of an output transport stream. *See, e.g.,* pages 5-6 of the instant Office Action. However, Applicant submits that such a modification would change the principle of operation of the McKissick reference in that the messages would no longer be stored on a server to be accessed by the intended recipients on an individual basis. In other words, the Examiner is improperly modifying the McKissick reference by replacing that which the invention is directed to *(i.e.,* the manner in which messages are exchanged between users of set top boxes). *See also, KSR Int'l Co. v. Teleflex, Inc.,* 127 S. Ct. 1727, 1742 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). Accordingly, there is no motivation for the skilled artisan to modify the McKissick reference in the manner proposed by the Examiner.

In view of the above, the § 103(a) rejections of claims 1-31 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejections of claims 1-31 because the Examiner fails to provide a valid reason or acceptable rationale for the proposed combination of the McKissick and Danker references, thus also failing to cite evidence of motivation for modifying the McKissick reference. Consistent with M.P.E.P. § 2143.01 and relevant case law, a § 103 rejection must provide evidence of motivation where a proposed combination of references would modify a primary reference. *See, e.g., KSRInt'lCo. v. Teleflexlnc,* 127 S. Ct. 1727, 1741 (U.S. 2007) ("A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art."). In this instance, the Examiner asserts that the skilled artisan would modify the McKissick reference to broadcast text messages along with television programming "for the purpose of allowing the transportation of the messages through the cable distribution infrastructure together with regular television programming, which avoids the need to include extra transmission mediums." *See* page 6 of the instant Office Action. However, this hypothetical combination lacks any supporting evidence, and further does not provide a clearly-articulated reason that would be consistent with the *KSR* decision. In particular, the McKissick reference already allows for messages to be sent using the same communication paths that carry television broadcast signals

thereby eliminating the need for additional communication paths *(see, e.g.,* paragraph 0013) as acknowledged and relied upon by the Examiner *(see, e.g.,* pages 2-3 of the instant Office Action).

Unlike the *KSR* decision, where the combination involved combining "two known devices according to their established functions", the Examiner's proposed combination does not involve simply combining teachings in which the cited references are not modified in their operation. More specifically, the proposed combination involves extensively modifying the McKissick reference by replacing the manner in which the McKissick reference exchanges messages between users of set top boxes, as discussed above. Accordingly, the Examiner's assertion of such a vague "articulated reasoning" *(e.g.,* to avoid "the need to include extra transmission mediums" which is already done by the McKissick reference) in support of the modification is insufficient. *KSR* and M.P.E.P. § 2141 make it clear that such assertions are inapplicable where the operation of one of the references is modified. *See, e.g., KSRInt'lCo. v. Teleflex Inc.,* 127 S. Ct. 1727, 1741 (U.S. 2007). For example, according to M.P.E.P. § 2141, Applicant can rebut such assertions of obviousness simply by showing that "the elements in combination do not merely perform the function that each element performs separately." This is also consistent with various parts of *KSR,* which repeatedly refer to combined teachings in which the cited references are not modified in their operation. Accordingly, the § 103(a) rejections of claims 1-31 are improper.

In view of the remarks above, Applicant believes that the rejection of each claim is improper and should be overturned by the BPAI.

8. Claims Appendix

Attached herewith please find an appendix containing the claims involved in the appeal.

9. Evidence Appendix

Attached herewith please find an appendix indicating that no other evidence was entered by the Examiner or relied upon by the Applicant.

10. Related Proceedings Appendix

Attached herewith please find an appendix indicating that no decisions have been rendered by a court or the Board related to this appeal.

Conclusion

For all of these reasons, Applicant respectfully submits that the rejections based upon and 35 U.S.C. 103 are in error and request the Board to affirm the patentability of the claims on appeal.

Respectfully submitted,

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APPENDIX – CLAIMS ON APPEAL

1. (Previously presented) A method of communicating comprising:

    receiving a text message from a user of a source set top box;

    transmitting the text message from the source set top box to an exchange;

    packetizing at the exchange said text message into a plurality of data packets, wherein said plurality of data packets include said text message, an identifier of said source set top box, an identifier of a destination set top box for the text message, and a packet header information;

    forwarding said plurality of data packets to a multiplexor;

    multiplexing said plurality of data packets and audio data and video data into an output transport stream; and

    broadcasting said output transport stream to a plurality of destination set top boxes, the plurality of destination set top boxes including the destination set top box for the text message.

2. (Previously presented) The method of claim 1, further comprising:

    assigning a reserved program identifier to the data packets, and wherein the output transport stream is an MPEG-2 format.

3. (Previously presented)The method of claim 2, further comprising:

    receiving the broadcasted output transport stream at each of the destination set top boxes;

    comparing the reserved program identifier to an identifier of each of the destination set top boxes; and

    responsive to the comparison, displaying the text message at each destination set top box having an identifier that matches the reserved program identifier.

4. (Previously presented) The method of claim 2, further including the step of demultiplexing the data packets, audio data and video data from the transport stream.

5. (Previously presented) The method of claim 1, further comprising:

   receiving said broadcasted output transport stream at each of the destination set top boxes.

6. (Original) The method of claim 1, wherein said transmitting is done via telephone or cable.

7. (Original) The method of claim 3, wherein said broadcasting is done via satellite, cable, or wireless.

8. (Original) The method of claim 5, wherein said receiving is done via satellite, cable, or wireless.

9. (Previously presented) The method of claim 4, further comprising:

   demultiplexing said broadcasted output transport stream at each of the destination set top boxes into said text message.

10. (Previously presented) A method of communicating comprising:

   receiving a text message from a first source set top box;

   packetizing said text message into a plurality of data packets, wherein said plurality of data packets include said text message, an identifier of a first destination set top box for the text message, an identifier of said first source set top box, and a packet header information;

   forwarding said plurality of data packets to multiplexor that produces a transport stream containing the data packets, audio data and video data; and

   broadcasting the transport stream to a plurality of destination set top boxes, the plurality of destination set top boxes including the first destination set top box.

11. (Previously presented) The method of claim 10, further including the step of receiving a text message from a second source set top box and wherein the plurality of

data packets includes the text message from the second source set top box, an identifier of a second destination set top box and an identifier of the second source set top box, wherein the plurality of destination set top boxes include the second destination set top box.

12. (Previously presented) The method of claim 11, wherein said receiving is via telephone, and further comprising:

receiving the broadcasted transport stream at each of the destination set top boxes;

comparing the identifiers of the first and second destination set top boxes contained in the data packets to an identifier of each of the destination set top boxes that received the broadcasted output transport stream;

responsive to the comparison, displaying the text message from the first source set top box at the destination set top box having an identifier that matches the identifier of the first destination set top box and displaying the text message from the second source set top box at the destination set top box having an identifier that matches the identifier of the second destination set top box.

13. (Original) The method of claim 10, wherein said receiving is via cable.

14. (Previously presented) A method of communicating comprising:

receiving a plurality of text messages, wherein said plurality of text messages originated at a plurality of source set top boxes;

packetizing said plurality of text messages into a plurality of data packets, the plurality of data packets including the text messages, an identifier of an intended destination set top box for each of the text messages and an identifier of the source set top box for each of the text messages;

multiplexing said plurality of data packets, audio data and video data into an output transport stream; and

broadcasting said output transport stream to a plurality of destination set top boxes, the plurality of destination set top boxes including the intended destination set top box for each of the text messages.

15. (Previously presented) The method of claim 14, wherein said plurality of text messages are received via telephone or cable and wherein the output transport stream is an MPEG-2 format.

16. (Original) The method claim 14, wherein said broadcasting is via satellite, wireless, or cable.

17. (Previously presented) The method of claim 14, further comprising:

demultiplexing said broadcasted output transport stream at said plurality of destination set top boxes into said plurality of text messages.

18. (Previously presented) The method of claim 14, further comprising:

receiving the broadcasted output transport stream at each of the destination set top boxes;

comparing the identifiers of the intended destination set top boxes contained in the received output transport stream to an identifier of each of the destination set top boxes; and

displaying each of the text messages at the destination set top box having an identifier that matches the identifier of the intended destination set top box for the text message.

19. (Previously presented) The method of claim 18, wherein said receiving is via satellite, cable, or wireless and where the output transport stream is an MPEG-2 format.

20. (Previously presented) A system for communicating comprising:

a service station adapted to receive a plurality of text messages sent from a plurality of source set top boxes, wherein said service station packetizes said plurality of text messages into a plurality of data packets, the plurality of data packets including the text messages, an identifier of an intended destination set top box for each of the text messages and an identifier of the source set top box for each of the text messages;

a multiplexor in communication with said service station adapted to multiplex said plurality of data packets, audio data and video data into an output transport stream; and

broadcasting means for broadcasting said output transport stream to a plurality of destination set top boxes, the plurality of destination set top boxes including the intended destination set top box for each of the text messages.

21. (Previously presented) The system of claim 20, wherein said broadcasting means is a satellite and wherein the output transport stream is an MPEG-2 format.

22. (Original) The system of claim 20, wherein said broadcasting means is cable.

23. (Original) The system of claim 20, wherein said broadcasting means is wireless means.

24. (Original) The system of claim 20, wherein said plurality of text messages received by said service station sent from said plurality of source set top boxes are received via telephone or cable.

25. (Original) The system of claim 20, further comprising:
     a source set top box connected via communication means with said service station.

26. (Original)The system of claim 25, wherein said communication means is telephone or cable.

27. (Original) The system of claim 20, further comprising:
     a destination set top box in communication with said broadcasting means.

28. (Original) The system of claim 27, wherein said destination set top box is in communication via satellite, cable, or wireless.

29. (Previously presented) A communication system comprising:
     transmitting means for transmitting a text message from a source set top box;
     packetizing means for packetizing said text message into a plurality of data packets, wherein said plurality of data packets include said text message, an identifier of said source set top box an identifier of a destination set top box for the text message, and packet header information;

multiplexing means, in communication with said packetizing means, for multiplexing said plurality of data packets, audio data and video data into an output transport stream; and

broadcasting means, in communication with said multiplexing means, for broadcasting said output transport stream to a plurality of destination set top boxes, the plurality of destination set top boxes including the destination set top box for the text message.

30. (Previously presented) The communication system of claim 29, wherein said transmitting is done via telephone or cable and wherein the output transport stream is an MPEG-2 format.

31. (Original) The communication system of claim 29, wherein said broadcasting is done via satellite, cable, or wireless.

APPENDIX - EVIDENCE

None.

APPENDIX - RELATED PROCEEDINGS

None.